

REMARKS

The Final Office Action mailed January 3, 2008, has been received and reviewed. Claims 1 through 58 are currently pending in the application. Claims 1 through 58 stand rejected. None of the claims have been amended herein. Applicants respectfully request reconsideration of the application in view of the arguments set forth herein below.

Supplemental Information Disclosure Statement

Please note that a Supplemental Information Disclosure Statement was filed herein on September 20, 2007, and that no copy of the PTO/SB/08A was returned with the outstanding Office Action. It is respectfully requested that an initialed copy of the PTO/SB/08A evidencing consideration of the cited references be returned to the undersigned attorney.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on NYRA One Account ("NYRA")

Claims 1-3, 5-10, 12-20, 23-32, 35-49, 51-55, and 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA One Account ("NYRA"). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is "an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common

knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.\

Claims 1-3, 5-10, 12-20 and 23

The 35 U.S.C. § 103(a) obviousness rejections of independent claim 1 is improper because NYRA fails to teach or suggest "placing a cashless purchase other than a pari-mutuel wager using the house card at the establishment to debit at least another portion of the funds of the monetary account," as recited in claim 1. NYRA teaches that withdrawals can be made from a card holder's account at the track using a method that is "fast and safe." *NYRA* at p. 2 and 4. However, these withdrawals require the cardholder to access a Sam machine, insert a card, select an amount to be withdrawn and exit the account. *Id.* at p. 4-5. A voucher is produced by the machine and the cardholder must take the voucher to a pari-mutuel window in order to exchange the voucher for cash. *Id.* at p. 5. At that point, the cardholder may use the cash to make a purchase other than a pari-mutuel wager. Such a process requires the use of cash to make the purchase and therefore fails to disclose a method including placing a cashless purchase.

The Examiner asserts that "cashless debiting systems for purchasing goods were notoriously well known at the time of Applicant's invention" without any support for this assertion or without a statement that the Examiner is taking Official Notice. *Final Action* at p. 9. Applicants respectfully traverse such an assertion and request the Examiner to cite a reference in support of this assertion and/or to submit a proper affidavit in support of this assertion.

Furthermore, the Examiner asserts that NYRA provides a rationale to use a method including placing a cashless purchase other than a pari-mutuel wager using the house card. Specifically, the Examiner asserts that NYRA teaches that one would want to use such a system to credit or debit the card holder's account without the inconvenience of waiting in line to cash tickets. However, the Examiner apparently disregards the explicit teaching in NYRA described above that a NYRA card-holder can make a purchase other than a pari-mutuel wager by retrieving a voucher from one of the Sam machines, and then waiting in line to cash the voucher

at one of the pari-mutuel windows. Indeed, Applicants assert that NYRA teaches away from such a combination. Specifically, NYRA teaches that the method of making withdrawals by retrieving a voucher from a Sam machine and cashing the voucher at a pari-mutuel window is beneficial in that it is “easy” for the cardholder as well as a “fast and safe.” See *NYRA* at p. 2. Thus, NYRA teaches that such a method of making withdrawals is safe for cardholders while also being quick and easy.

As NYRA fails at least to teach or suggest “placing a cashless purchase other than a pari-mutuel wager using the house card at the establishment to debit at least another portion of the funds of the monetary account,” as recited in independent claim 1, Applicants respectfully assert that independent claim 1 would not have been obvious to a person of ordinary skill in the art at the time the invention was made based on the description of NYRA, and request that the Examiner withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

Furthermore, the nonobviousness of independent claim 1 precludes a rejection of claims 2, 3, 5-10, 12-20 and 23, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 2, 3, 5-10, 12-20 and 23, in addition to the rejection to independent claim 1.

Regarding dependent claim 17-19, Applicants additionally assert that NYRA does not teach or suggest forwarding information regarding an outcome of the pari-mutuel wager. NYRA only teaches the ability to retrieve information regarding, *inter alia*, race results using a telephone. *NYRA* at p. 13. Nothing in NYRA teaches forwarding information. Instead, in NYRA the user is required to access a telephone and call the specified number to retrieve the information. The Examiner asserts a two step process in NYRA including retrieving and then forwarding the information. However, such a two step process would be redundant and unnecessary. In particular, there is no need to forward the information if it has already been retrieved. Thus, the fact that the information is retrieved by a user teaches away from forwarding the information. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 17-19 under 35 U.S.C. § 103(a) for this additional reason.

Regarding dependent claim 20, Applicants additionally assert that NYRA fails to teach or describe “selecting the house card to be associated with a first monetary account and with a second monetary account associated with a debit card account or a credit card account,” as recited in dependent claim 20. The Examiner fails to particularly recite any disclosure in NYRA relating to claim 20. Indeed, nothing in NYRA discloses a house card associated with more than one account, and, more particularly, with a monetary account associated with a debit or credit card account. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Claims 24-32 and 35-39

The rejection of independent claim 24 is improper because NYRA fails to disclose “presenting a credit card or a debit card associated with a monetary account to a card reader in communication with the gaming terminal; accessing at least a portion of funds of the monetary account for use at the gaming terminal; placing a pari-mutuel wager at the gaming terminal on an event using the at least a portion of the funds; and placing a cashless purchase other than placing a pari-mutuel wager using the credit card or the debit card at the establishment to debit at least another portion of the funds of the monetary account,” as recited in claim 24. NYRA teaches the use of a house card to place a pari-mutuel bet using a Sam machine or a Tiny Tim machine. *NYRA* at p. 6-9. The card is associated with a single account that is not associated with any credit card or debit card accounts. *See Id.* at p. 1-13. Bets can only be placed by presenting the NYRA Account wagering card, as opposed to presenting a credit card or debit card. Additionally, the NYRA Account wagering card is not associated with any monetary account associated with a credit card or a debit card and the Examiner has made no assertions to the contrary. This is further supported by the fact that NYRA discloses the need to call an operator, be transferred to an agent, and request a transfer from a credit or debit card account to the NYRA account. Such a method would not be necessary if the house card comprised a credit card or a debit card or was associated with the credit card or debit card account. The Examiner has failed to respond to this distinction and fails to point out how NYRA teaches or suggests such features.

As NYRA fails at least to teach or suggest the features listed above recited in independent claim 24, Applicants respectfully assert that independent claim 24 would not have been obvious to a person of ordinary skill in the art at the time the invention was made based on the description of NYRA, and request that the Examiner withdraw the rejection of independent claim 24 under 35 U.S.C. § 103(a).

Furthermore, the nonobviousness of independent claim 24 precludes a rejection of claims 25-32 and 35-39, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 25-32 and 35-39, in addition to the rejection to independent claim 24.

Regarding dependent claim 37- 39, Applicants additionally assert that NYRA does not describe forwarding information regarding an outcome of the pari-mutuel wager over a communication link. NYRA only discloses the ability to retrieve information regarding, *inter alia*, race results. *NYRA* at p. 13. The Examiner asserts a two step process in NYRA including retrieving and then forwarding the information. However, such a two step process would be redundant and unnecessary. In particular, there is no need to forward the information if it has already been retrieved. Thus, the fact that the information is retrieved by a user teaches away from forwarding the information. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claims 37-39 under 35 U.S.C. § 103(a) for this additional reason.

Claims 40-49, 51-55, and 58

The rejection of independent claim 40 is improper because NYRA fails, at least, to disclose “placing a purchase of goods or services sold at an establishment, other than a pari-mutuel wager, over the communication link using another portion of the funds,” as recited in claim 40. As discussed above, NYRA is limited to placing a pari-mutuel wager using a card and a Sam or Tiny Tim machine at a race track or, alternatively, over the phone. The user is limited to placing a wager and cannot make any purchases of goods or services using the card, and, more particularly, purchase goods or services over a communication link. Again, the Examiner has not

asserted any such disclosure in NYRA nor given any reason why NYRA should be read as teaching such elements.

As NYRA fails at least to teach or suggest the features of independent claim 40 listed above, Applicants respectfully assert that independent claim 40 would not have been obvious to a person of ordinary skill in the art at the time the invention was made based on the description of NYRA, and request that the Examiner withdraw the rejection of independent claim 40 under 35 U.S.C. § 103(a).

Furthermore, the nonobviousness of independent claim 40 precludes a rejection of claims 41-49, 51-55, and 58, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 41-49, 51-55, and 58, in addition to the rejection to independent claim 40.

Regarding dependent claim 51, Applicants additionally assert that NYRA fails to teach or suggest “selecting the monetary account to be associated with a debit or credit card,” as recited in dependent claim 51. The Examiner fails to particularly recite any teaching or suggestion in NYRA relating the claim 51. Indeed, nothing in NYRA teaches a house card associated with a debit or credit card account. Instead, a user must make a transfer from a credit or debit card by calling an operator, be transferred to an agent, and then request the transfer. *See NYRA* at p. 4. If the account were associated with a credit or debit card, such a method for transferring funds from a credit or debit card would not be necessary. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Regarding dependent claim 55, Applicants additionally assert that NYRA fails to teach or suggest “selecting the house card to be associated with a first monetary account and with a second monetary account associated with a debit card account or a credit card account,” as recited in dependent claim 55. Nothing in NYRA teaches a house card associated with more than one account. Additionally, as discussed above, NYRA does not teach the use of a monetary account associated with a debit or credit card account. Therefore, Applicants respectfully request

that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,307,956 to Black

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Black (U.S. Patent No. 6,307,956). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 4 is dependent from claim 1 and further requires using the house card to access a secure area at the establishment. The Examiner relies on NYRA as disclosing all of the limitations of claim 1 in combination with Black. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claim 1. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 4, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,558,255 to Walker

Claims 11 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Walker (U.S. Patent No. 6,558,255). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 11 is dependent from claim 1 while claim 50 is dependent from claim 40. Claims 11 and 50 further require selecting the house card to have a predenominated amount of funds. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Walker. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 11 and 50, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,379,248 to Jorasch *et al.*

Claims 21, 22, 56 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Jorasch *et al.* (U.S. Patent No. 6,379,248). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 21 and 22 depend indirectly from claim 1 while claims 56 and 57 depend indirectly from claim 40. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Jorasch *et al.* As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 21, 22, 56 and 57, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,547,131 to Foodman

Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Foodman (U.S. Patent No. 6,547,131). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 33 and 34 depend indirectly from claim 24. The Examiner relies on NYRA as disclosing all of the limitations of claim 24 in combination with Foodman as disclosing the limitations in claims 33 and 34. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 24. Therefore, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 33 and 34, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

CONCLUSION

Claims 1 through 58 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tyler J. Barrett", with a stylized flourish at the end.

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